

REMARKS

Claims 16-22, 24 and 33-44 are now pending in the application, with claims 16 and 43 being the independent claims. Reconsideration and further examination are respectfully requested.

In the Office Action, Applicants are required to elect from among the following two purported species:

- I. The method as shown in Figures 6, 7A and 7B
- II. The method as shown in Figures 8, 9A and 9B

Applicants affirm the election of purported species I, Claims 16-24, in a previous telephone call with the Examiner. In the claim amendments set forth above, all non-elected claims have been canceled from the application.

In the Office Action, objection was made to former claim 23 under 35 USC § 112, second paragraph. In response, it is noted that the “preformed piece of second durable material” corresponds, e.g., to skeleton 220 which is shown in Figure 12 and discussed, e.g., on pages 15-17 of the Specification. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 16-19 and 22 were rejected under 35 USC § 102(e) over U.S. Patent Publication No. 20030121179 (Chen); claims 16-19 were rejected under § 102(b) over U.S. Patent 4,899,467 (Mackey); claims 16-19 were rejected under § 102(e) over U.S. Patent 6,032,388 (Fram); claim 20 was rejected under § 103(a) over any of Fram, Mackey and Chen; claims 21 and 24 were rejected under § 103(a) over Chen; and claim 23 was rejected under § 103(a) over any of Fram, Mackey and Chen in view of U.S. Re. 35,905 (Vincent). Withdrawal of these rejections is respectfully requested for the following reasons.

Initially, it is noted that the substance of former dependent claim 23 has been incorporated into independent claim 16, and claim 23 has been canceled above. Claim 16 also has been amended to clarify that the piece of perforated material is placed into the mold on top of the preformed piece of material. See, e.g., page 15 lines 23-25 and Figure 12 of the Specification.

Accordingly, independent claim 16 is directed to a method for forming the bottom portion of a shoe, in which a preformed piece of material is placed into a mold for the bottom portion of a shoe. Subsequently, a piece of perforated material is placed into the mold, and then a durable material is inserted into the mold on top of the perforated material, subject to at least one of the following: (i) the durable material is injected into the mold in liquid form, and (ii) at least a portion of the durable material nearest to the perforated material is caused to melt after insertion into the mold. Finally, the durable material is caused to harden into solid form. In accordance with this aspect of the invention, the preformed piece of material is substantially more durable than the perforated material.

The foregoing combination of features is not disclosed or suggested by the applied art. For example, the applied art does not disclose or suggest at least the sequence of placing a preformed piece of material into a mold for the bottom portion of a shoe, placing a piece of perforated material into the mold on top of the preformed piece of material and then inserting a durable material into the mold on top of the perforated material, with the durable material subsequently hardening into solid form.

In fact, the Office Action appears to acknowledge that neither Fram, Mackey nor Chen individually discloses this combination of features. In order to make up for this deficiency, the Office Action cites Vincent's insertion of a wrap into a mold and then asserts that it would have

been obvious to insert such a wrap into any of the molds used by Fram, Mackey or Chen, for the purpose of providing an ornamental design.

However, it is first noted that Vincent only discloses the insertion of a wrap into a mold for forming a *midsole*, and not into “a mold for the *bottom portion of a shoe* [emphasis added]”, as presently recited. In fact, Vincent expressly notes that a separate outsole would be attached to the bottom surface of his midsole. See, e.g., column 3 lines 64-67 of Vincent.

In addition, if such a wrap were to be inserted into any of the molds used by Fram, Mackey or Chen, the corresponding perforated material then would be placed *within* the wrap. That is, the wrap would surround the perforated material in any such hypothetical combination. This is different than the method recited in independent claim 16, which has been amended to clarify that the piece of perforated material is placed into the mold *on top of* the preformed piece of material.

Based on these distinctions, it is not believed that any permissible combination of Vincent with any of Fram, Mackey or Chen would have suggested the method recited in independent claim 16. Accordingly, claim 16 is believed to be allowable over the applied art.

New claim 33 depends from independent claim 16 and recites the additional feature that the durable material is injected into the mold in liquid form. This feature clarifies which of the options recited in independent claim 16 applies and, particularly in combination with the other features recited in claim 16, is not believed to be disclosed or suggested by the applied art.

New claim 34 depends from independent claim 16 and recites the additional feature that the durable material is inserted into the mold in solid form. This feature is supported, e.g., at page 9 lines 11-13 of the Specification and, particularly in combination with the other features recited in claim 16, is not believed to be disclosed or suggested by the applied art.

New claim 35 depends from independent claim 16 and recites the additional feature that perforations in the piece of perforated material form a design pattern. This feature is supported, e.g., at page 8 lines 9-10 of the Specification and, particularly in combination with the other features recited in claim 16, is not believed to be disclosed or suggested by the applied art.

New claim 36 depends from independent claim 16 and recites the additional feature that the piece of perforated material has at least one of (i) frayed edges and (ii) a plurality of projections. This feature is supported, e.g., at Page 9 lines 5-8 of the Specification and, particularly in combination with the other features recited in claim 16, is not believed to be disclosed or suggested by the applied art.

New claim 37 depends from independent claim 16 and recites the additional feature that the preformed piece of material has been formed by injection molding. This feature is supported, e.g., at page 15 lines 8-10 of the Specification and, particularly in combination with the other features recited in claim 16, is not believed to be disclosed or suggested by the applied art.

New claim 38 depends from independent claim 16 and recites the additional feature that the preformed piece of material includes a plurality of openings. This feature is supported, e.g., at page 15 lines 10-11 of the Specification and, particularly in combination with the other features recited in claim 16, is not believed to be disclosed or suggested by the applied art.

New claims 39 and 41 depend from independent claim 16 and dependent claim 40, and each recites the additional feature that the preformed piece of material has approximately a same size and shape as the mold, such that the preformed piece of material just fits within the mold. This feature is supported, e.g., at page 15 lines 10-13 and Figure 12 of the Specification and, particularly in combination with the other features recited in the claims from which the respective claims depend, is not believed to be disclosed or suggested by the applied art.

New claim 40 depends from independent claim 16 and recites the additional feature that the piece of perforated material is approximately a same size as the preformed piece of material. This feature is supported, e.g., at page 15 lines 23-25 of the Specification and, particularly in combination with the other features recited in claim 16, is not believed to be disclosed or suggested by the applied art.

New claim 42 depends from independent claim 16 and recites the additional feature that the piece of perforated material is larger than an interior of the mold, whereby portions of the piece of perforated material extend upwardly along the inner walls of the mold. This feature is supported, e.g., at page 15 lines 23-25 of the Specification and, particularly in combination with the other features recited in claim 16, is not believed to be disclosed or suggested by the applied art.

New claims 43 and 44 are product-by-process claims corresponding to claims 16 and 39, respectively. Accordingly, such claims are believed to be allowable for at least the same reasons set forth above with respect to claims 16 and 39.

The other rejected claims in this application depend from the independent claims discussed above, and are therefore believed to be allowable for at least the same reasons. Because each dependent claim also defines an additional aspect of the invention, however, the individual reconsideration of each on its own merits is respectfully requested.

In order to sufficiently distinguish Applicants' invention from the applied art, the foregoing remarks emphasize several of the differences between the applied art and Applicants' invention. However, no attempt has been made to categorize each novel and unobvious difference. Applicants' invention comprises all of the elements and all of the interrelationships between those elements recited in the claims. It is believed that for each claim the combination

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of such elements and interrelationships is not disclosed, taught or suggested by the applied art. It is therefore believed that all claims in the application are fully in condition for allowance, and an indication to that effect is respectfully requested.

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Respectfully submitted,
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